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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ADRIAAN RETIEF SWANEPOEL

Appeal 2008-1301
Application 09/806,800
Technology Center 3700

Decided: May 28, 2008

Before DONALD E. ADAMS, RICHARD M. LEBOVITZ, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to windscreen wipers. The Examiner has rejected the claims as having new matter, being anticipated, and being obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the anticipation and obviousness rejections, but reverse the new matter rejection.¹

¹ In this decision we consider only those arguments actually made by Appellant. Arguments that Appellant could have made but chose not to

STATEMENT OF THE CASE

Claims 1-10, 13, and 14 are pending and on appeal (App. Br. 4).² Of these, claims 1, 2, 13, and 14 are independent, and read as follows:

1. A beam blade windscreen wiper which includes an elongate curved backbone which is made of a single, unitary, resiliently flexible beam; and a force applying member which is connected to the backbone at two spaced apart points with the spacing distance S (expressed in millimetres) between the points being between
- $$S_1 = 0.1 * L \dots\dots\dots (1)$$

and

$$S_2 = 0.35 * L \dots\dots\dots (2)$$

where the length L is the total length of the backbone expressed in millimetres.

2. A beam blade windscreen wiper which includes an elongate curved backbone which is made of a single, unitary, resiliently flexible beam; and a force applying member which is connected to the backbone at two spaced apart points with the ratio R of spacing distance S between the points and the total length L ($R = S/L$) being between
- $$R_1 = 0.1 \dots\dots\dots (3)$$

and

$$R_2 = 0.35 \dots\dots\dots (4)$$

where the spacing distance S and the length L are expressed in the same units of measure.

13. A beam blade windscreen wiper which includes an elongate curved backbone which is of a resiliently flexible material; and

make in the Briefs have not been considered and are deemed to be waived.
See 37 C.F.R. § 41.37(c)(1)(vii).

² Appeal Brief filed January 31, 2007.

a force applying member which is connected to the backbone at two spaced apart points with the spacing distance S (expressed in millimetres) between the points being between

$$S_1 = 0.15 * L \dots\dots\dots (1)$$

and

$$S_2 = 0.35 * L \dots\dots\dots (2)$$

where the length L is the total length of the backbone expressed in millimetres.

14. A beam blade windscreen wiper which includes an elongate curved backbone which is made of a single, unitary, resiliently flexible beam; and a force applying member which is connected to the backbone at two spaced apart points with the spacing distance S (expressed in millimetres) between the points being between

$$S_1 = 0.1 * L \dots\dots\dots (1)$$

and

$$S_2 = 0.35 * L \dots\dots\dots (2)$$

where the length L is the total length of the backbone expressed in millimeters, and wherein at one of the points, the force applying member is connected to the backbone by means of a pin which is received in a longitudinal slot in the backbone so that relative longitudinal and pivotal movement between the pin and the backbone is permitted.

The Examiner applies the following documents in rejecting the claims:

Appel	US 3,192,551	Jul. 6, 1965
Wittwer	US 3,899,800	Aug. 19, 1975
Thompson	US 4,587,686	May 13, 1986

The following rejections are before us for review:

Claims 1-10, 13, and 14 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Ans. 3).

Claims 1-5, 7-10, 13, and 14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Wittwer as evidenced by Thompson (Ans. 3-5).

Claim 6 stands stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Wittwer and Appel (Ans. 5-6).

WRITTEN DESCRIPTION (NEW MATTER)

ISSUE

The Examiner contends that claims 1-10, 13, and 14 fail to comply with the written description requirement because Appellant amended the claims to “include the newly added limitation of a ‘beam blade’”. This is considered new matter and requires further consideration” (Ans. 3). The Examiner contends that Appellant’s arguments in a previously filed appeal brief “imply that the new limitation of ‘beam blade’ gives structure to the claim. There is no discussion in the original specification or the claims as to what a ‘beam blade’ is or how it is different than any other wiper. Consequently, the term ‘beam blade’ is not supported by the original specification” (*id.*).

Appellant contends that a person of ordinary skill in the art would have recognized possession of the claimed invention at the time of filing because the Specification and Figure 1 disclose “that the invention relates to a windscreen wiper having a curved elongate backbone and that the backbone may be in the form of a beam” (App. Br. 20). Based on these disclosures, Appellant contends, it is evident that the invention is “directed toward a certain type of windshield wiper assembly commonly known in the art as a ‘beam blade.’ Beam blade windshield wiper assemblies do not have a ‘super structure’ as that term is commonly used in connection with ‘tournament style’ windshield wiper systems - another well known term in

the art” (*id.* at 21). Appellant further contends that one skilled in the art “would reasonably understand that the present invention is directed toward a beam blade type windshield wiper assembly (as opposed to a tournament style windshield wiper assembly) from an initial, cursory inspection of Figure 1 and even before reference was made to the written description” (*id.*).

The issue, then, is whether Appellants have shown that the Examiner erred in finding that the originally filed disclosure failed to provide adequate descriptive support for the claim term “beam blade windscreen wiper.”

FINDINGS OF FACT (“FF”)

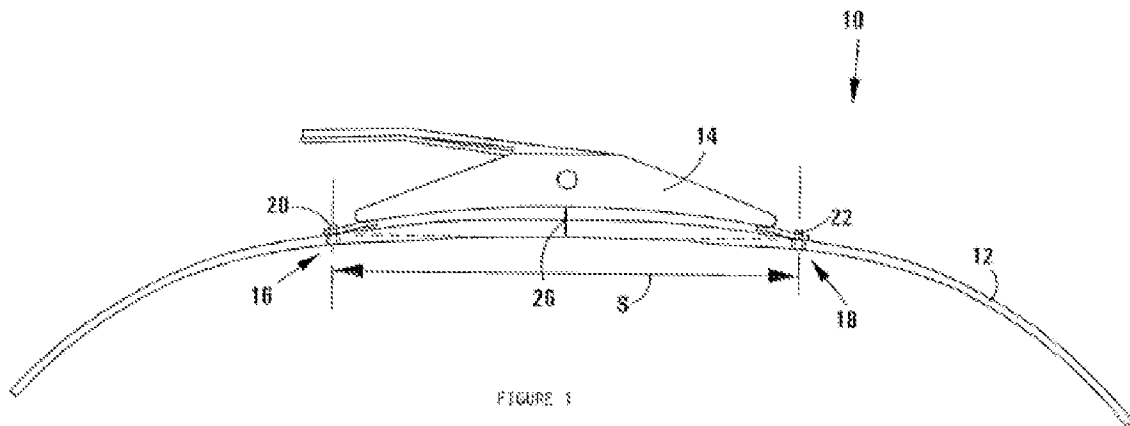
1. The preambles of all of the pending claims recite a “beam blade windscreen wiper.”
2. Appellant inserted the recitation “beam blade” into the preambles of all of the pending claims in an Amendment filed July 8, 2005 (Amendment 2-4 (July 8, 2005)).
3. The Specification does not contain the recitation “beam blade windscreen wiper.”
4. The Specification does not define “beam blade windscreen wiper.”
5. Appellant has not provided any evidence supporting the assertion that “beam blade windscreen wiper” is a well known term in the art.
6. Appellant has not provided any evidence showing that one skilled in the art would consider the terms “beam blade windscreen wiper” and “tournament style windshield wiper” to be mutually exclusive terms.
7. The Specification states:

The invention relates in particular to a windscreen wiper which has a curved backbone and which may have a varying width and/or thickness. It will be appreciated by those skilled in

the art that the backbone may be in the form of a beam that is curved in a plane or may have compound curvature. The beam will then usually have width and thickness dimensions. The beam will also have a radius of curvature at each point along its length.

(Spec. 1.)

8. Figure 1, reproduced below, “shows schematically a windscreen wiper in accordance with the invention” (Spec. 4):



The figure shows “windscreen wiper 10 [which] includes a backbone 12 which is in the form of a beam. The beam is made from spring steel having a Young's modulus of 205GPa. The length of the beam is 700 mm. The beam tapers both in width and thickness from its centre toward its free ends or tips” (Spec. 5).

PRINCIPLES OF LAW

As stated in *TurboCare Div. of Demag Delaval Turbomachinery Corp. v. General Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001):

The written description requirement and its corollary, the new matter prohibition of 35 U.S.C. § 132, both serve to ensure that the patent applicant was in full possession of the claimed subject matter on the application filing date. When the applicant adds a claim or otherwise amends his specification after the

original filing date . . . , the new claims or other added material must find support in the original specification.

The test for determining whether a specification is sufficient to support a particular claim “is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed.Cir.1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375 (Fed.Cir.1983)). Thus, “[i]t is not necessary that the application describe the claim limitations exactly, . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations.” *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976) (citation omitted).

Regarding claim language, during examination the PTO must interpret terms in a claim using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

ANALYSIS

When the term “beam blade windscreen wiper” is given its broadest reasonable interpretation consistent with the Specification, we agree with Appellant that the Examiner failed to show lack of possession of the claimed subject matter at the time of filing.

We agree with the Examiner that the Specification neither recites nor defines the term “beam blade windscreen wiper” (FF 3-4). However, the

Specification nonetheless discloses a windscreen wiper with a blade portion having as its backbone a single structure described as a “beam” (*see* FF 7-8). Therefore, given the Specification’s disclosure of windscreen wipers that have a blade portion with a backbone structure identified as a “beam,” we agree with Appellant that the claimed subject matter was possessed at the time the application was filed.

The Examiner urges that, based on Appellant’s arguments, the term “beam blade windscreen wiper” imparts structural limitations into the claims beyond the words contained in the term (Ans. 3). Appellant argues that “beam blade windscreen wiper” is a well known term in the art, which a skilled artisan would recognize as being distinct from a “tournament style” wiper (App. Br. 21).

We are not persuaded by these arguments. Neither the Examiner nor Appellant points to any disclosure in the Specification, or other evidence, showing that the term “beam blade windscreen wiper” has a well known meaning in the art that would place additional limitations on the claimed windscreen wipers beyond a blade portion with a beam backbone. Therefore, on this record, we conclude that it is reasonable to interpret “beam blade windscreen wiper” as encompassing windscreen wipers that have a blade portion with a backbone structure that can be considered a beam.

Because we find that the Specification supports our interpretation of the phrase “beam blade windscreen wiper”, we agree that a person skilled in the art would have recognized that Appellant possessed the claimed subject matter at the time of filing. We therefore reverse the Examiner’s written description rejection of claims 1-10, 13, and 14.

ANTICIPATION

ISSUE

Claims 1-5, 7-10, 13, and 14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Wittwer as evidenced by Thompson (Ans. 3-5).

The Examiner cites Wittwer as disclosing “a wiper comprising a force-applying member (12) connected to the center backbone at two spaced apart points (31, 32). The backbone or backing strip is [] formed from a single, unitary, flexible material that is precurved or prebowed in a direction substantially parallel to the curvature of the windshield” (*id.* at 4). The Examiner concedes that Wittwer does not use the term “beam” to refer to the blade’s backing strip, and therefore cites Thompson as disclosing “a wiper blade with a beam . . . that could be used on a tournament style wiper” (*id.* (citation omitted)).

The Examiner states that Wittwer’s wiper has “a superstructure with four pairs of equally spaced apart claws (30, 31, 32 and 33) that slidably engage with the backing strip or beam (36) by means of claws with pin type structure that engage around the outer exposed longitudinal slot edge portions of the flexible backing strip” (*id.*). The Examiner contends that Wittwer meets the limitations regarding the spacing of the connecting points of the force applying member because of the equal spacing between the four claws, and because Wittwer discloses that the two outermost claws are 1/8 the length of the wiper from the end of the blade (*id.*). Thus, the Examiner contends, “[i]t can be determined that the spacing between the two points (31, 32) is $\frac{1}{4}$ the length of the wiper blade and the ratio of spacing to the total length is $\frac{1}{4}$. . . , therefore, $S=0.25*L$ and $R=0.25$ which falls in the ranges claimed by the [A]ppellant” (*id.*).

Appellant contends that the Examiner has improperly combined two references in an anticipation rejection (App. 21-22). Appellant contends that the Examiner has not shown that Wittwer anticipates the cited claims because Wittwer discloses a tournament style wiper rather than a beam blade wiper (*id.* at 22), because the Examiner has improperly measured Wittwer's drawings to determine the spacing between the attachment points of Wittwer's wiper (*id.* at 23-24), and because Wittwer does not meet the independent claims' limitations regarding attachment points (*id.* at 24-25).

While Appellants state that dependent claims 2-5 and 7-10 "add perfecting limitations" to claims 1 or 2 (*id.* at 26), Appellants do not present separate arguments for those claims. The issue with respect to this rejection, therefore, is whether Appellant has shown that the Examiner erred in finding that Wittwer meets all of the limitations recited in claims 1, 2, 13, and 14.

FINDINGS OF FACT

9. Claim 1 recites a beam blade windscreen wiper that has an elongate curved backbone made of a single, unitary, resiliently flexible beam. The backbone has a force applying member connected to it at two spaced apart points with the spacing distance "S."

The distance between the two connecting points must be at least " $S_1 = 0.1 * L$ ", or one-tenth of the total length of the backbone, and at most " $S_2 = 0.35 * L$ ", or thirty-five one-hundredths of the total length of the backbone, with the distance expressed in millimeters.

10. Claim 2 also recites a beam blade windscreen wiper that has an elongate curved backbone made of a single, unitary, resiliently flexible beam. The backbone has a force applying member connected to it at two spaced apart points, with the ratio R of spacing distance S between the

points and the total length L ($R = S/L$) being between “ $R_1 = 0.1$ ” and “ $R_2 = 0.35$.” The distance between the two connecting points must therefore be at least one-tenth the total length of the backbone, and no more than thirty-five one hundredths of the total length of the backbone.

11. Claim 13 is similar to claim 1, except that claim 13’s windscreen wiper is not limited to having a backbone with a single, unitary construction. Also, claim 13 limits the minimum spacing between the connecting points to fifteen one-hundredths of the total length of the backbone.

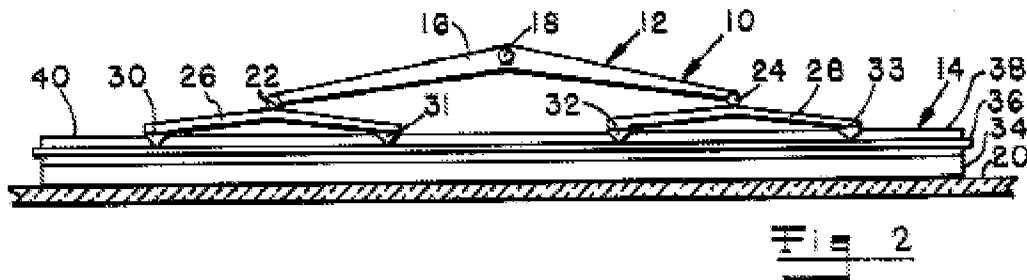
12. Claim 14 has all of the limitations of claim 1, and has the additional requirement that, at one of the attachment points, the force applying member is connected to the backbone by a pin that is received in a longitudinal slot in the backbone so as to permit relative longitudinal and pivotal movement between the pin and the backbone.

13. Wittwer discloses a “wiper blade element . . . comprised of a resilient wiping member 34 and a flexible backing strip or flexor 36. The backing strip 36 is nested in a pair of sidewardly opening grooves formed in the head portion 38 of said wiping member 34” (Wittwer, col. 2, ll. 45-50).

Wittwer states that “[t]he flexible backing strip 36 is formed of an appropriate metal or plastic material and is an elongate planar member which is relatively flexible in a direction perpendicular to the surface being wiped and is relatively inflexible in a plane transverse thereto, i.e., in a plane substantially parallel to the surface to be wiped” (*id.* at col. 2, ll. 50-57).

Wittwer discloses that “[t]he flexible backing strip 36 is precurved or prebowed in a direction substantially parallel to the curvature of the windshield” (*id.* at col. 2, ll. 57-59).

14. Figure 2 of Wittwer, reproduced below, “is an elevational view of a windshield wiper blade assembly positioned on a windshield showing a triple yoke superstructure” (Wittwer col. 2, ll. 15-17):

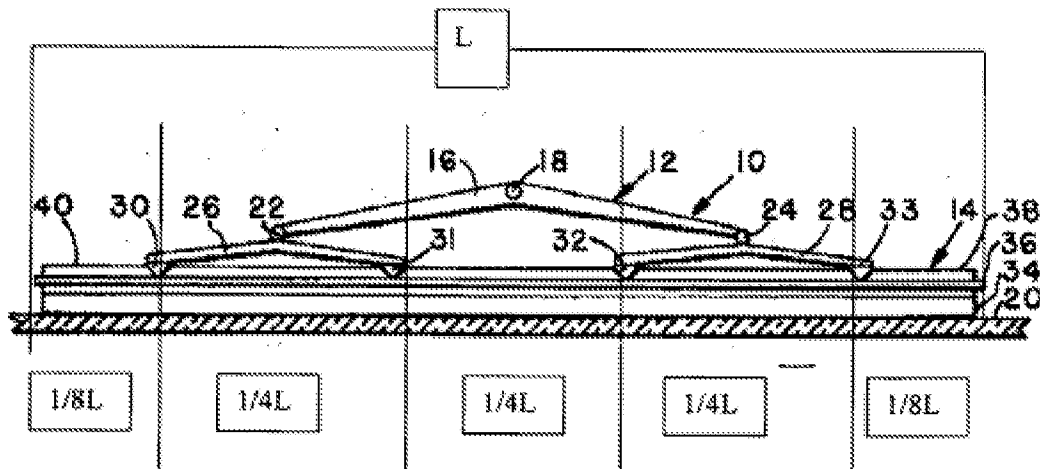


The figure shows the force-applying “superstructure 12 with the four pairs of equally spaced apart claws 30, 31 and 32, 33 [which] slidably engage with the flexible backing strip 36 by means of the claws engaging around the outer exposed edge portions of said flexible backing strip” (*id.* at col. 2, ll. 64-67). Wittwer discloses that “[t]he remote claws 30, 33 of the secondary yokes 26 and 28 each engage with the backing strip at a location spaced one-eighth the length of the wiper blade element in from the ends” (*id.* at col. 2, l. 67, through col. 3, l. 2).

15. Wittwer discloses that its arrangement of attachment points allows “pressure from the wiper arm [to] be distributed to four equally spaced apart points along the backing strip with the two remote points being located one-eighth the length of the wiper element in from the ends of the blades so that as the blade is brought against the surface of the windshield, the pressure will conform the wiping lip of the wiping member 34 to the curvature of the surface of the windshield” (Wittwer, col. 3, ll. 7-15).

16. Based on Wittwer’s disclosure of four equally spaced attachment points with the outermost points being one-eighth of the length in from the

blades' ends, the Examiner produced the following annotated version of Wittwer's Figure 2 (Ans. 9):



The Examiner's annotated figure shows end-most attachment points 30 and 33 being one-eighth the length of the wiper element from the ends of the blade. The Examiner's annotated figure shows the distance between the central attachment points as being " $\frac{1}{4} L$ " which, using the terminology in Appellant's claims, corresponds to $0.25 * L$. The ratio of the distance between the two central attachment points and total length of the blade is therefore 0.25.

17. Thompson discloses a windshield wiper having "an elliptical support beam . . . [which] serves to uniformly deliver, along the length of the adjacent wiper portion, the force transmitted to it by the superstructure" (Thompson, col. 10, ll. 13-18). Thompson states that the wiper embodiments using the beam are "suitable for use with virtually any style of superstructure" (*id.* at col. 10, ll. 27-28)

PRINCIPLES OF LAW

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." *In re*

Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997). In determining whether a reference discloses a claim's limitations, "extrinsic evidence may be considered when it is used to explain, but not expand, the meaning of a reference." *In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991).

ANALYSIS

Appellant's arguments do not persuade us that the Examiner erred in finding that Wittwer discloses all of the limitations in claims 1, 2, 13, and 14.

Appellant argues that it was improper for the Examiner to rely on more than one reference to establish anticipation (App. Br. 21-22). However, the Examiner applied Thompson only to explain that one skilled in the art would consider Wittwer's "flexible backing strip" (*see* FF 14-15) to be a "beam" regardless of the configuration of the force-applying structure attached to it (*see* FF 18). Thus, because the Examiner used Thompson to explain rather than expand Wittwer's disclosure, we do not agree that the Examiner's use of extrinsic evidence was improper in this anticipation rejection. *See In re Baxter Travenol Labs.*, 952 F.2d at 390.

Appellant argues that, because Wittwer discloses "a traditional mounting method for a tournament style windscreen wiper assembly, and because the backing strip 36 does not independently force a wiper blade transversely onto the windshield, . . . a person having ordinary skill in the art would not recognize the traditional backing strips 36 as being a backbone made of a single, unitary, resiliently flexible beam" (App. Br. 22).

We are not persuaded by this argument. Appellant does not point to, nor do we see, any evidence of record that the term "beam blade windscreen wiper" is a well known term in the art that excludes the type of force-

applying structure used by Wittwer (*see* FF 3-7). Rather, as discussed above, when “beam blade windscreen wiper” is given its broadest reasonable interpretation consistent with the Specification, the term encompasses windscreen wipers that have a blade portion with a backbone structure that can be considered a beam. In view of Thompson’s use of the term “beam” to describe a backing element running the length of a wiper blade (FF 17), we agree with the Examiner that it was reasonable to conclude that Wittwer’s flexible backing strip can be considered a “beam,” as that term is used in the claims.

Wittwer states that its “flexible backing strip 36 . . . is *an elongate planar member* which is relatively flexible in a direction perpendicular to the surface being wiped” (Wittwer, col. 2, ll. 50-53 (FF 14) (emphasis added)). Thus, because Wittwer refers to the flexible backing strip as a single member, we agree with the Examiner that it was reasonable to find that the backing strip meets the limitation in claims 1, 2, and 14 requiring a flexible beam with a “single, unitary” structure. Moreover, because Wittwer discloses that “[t]he flexible backing strip 36 is precurved or prebowed in a direction substantially parallel to the curvature of the windshield” (*id.* at col. 2, ll. 57-59 (FF 14)), we agree with the Examiner that Wittwer meets the limitations in claims 1, 2, 13, and 14 requiring the flexible beam to be curved.

Appellants argue that it was improper for the Examiner to rely on measurements taken from Wittwer’s drawings to establish the relative spacing between the connecting points on Wittwer’s flexible backing strip (App. Br. 23 (citing *Hockerson-Halberstadt, Inc. v. Avia Group Int’l, Inc.*, 222 F.3d 951 (Fed. Cir. 2000))). The Examiner responds that “[n]o

measurements were made on the drawings to determine the distance between the claws with respect to the length. This information is directly from the reference” (Ans. 9). The Examiner reasons that, “since the ratios of length are known for each claw, it is easily determined that the [A]ppellant’s claimed spacing distance S (distance between claws 31 and 32) is equal to .25L (no measurements needed) and [A]ppellant[‘s] claimed ratio of spacing between points and total length ($R=S/L$) is [0].25” (*id.*).

We agree with the Examiner that Wittwer meets the limitations in claims 1, 13, and 14 regarding the spacing between the force-applying member’s attachment points. Wittwer discloses that its force-applying superstructure engages the flexible backing strip with “four pairs of equally spaced apart claws 30, 31 and 32, 33” (Wittwer, col. 2, ll. 64-67; *see also* Fig. 2 (FF 15)). Wittwer also discloses that “[t]he remote claws 30, 33 of the secondary yokes 26 and 28 each engage with the backing strip at a location spaced one-eighth the length of the wiper blade element in from the ends” (*id.* at col. 2, l. 67, through col. 3, l. 2).

Thus, rather than being based on measurements of Wittwer’s drawings, the Examiner’s annotated version of Wittwer’s Figure 2 (*see* FF 17), is based on explicit disclosures in the reference, as is the Examiner’s conclusion that the spacing between connecting points 31 and 32 is 0.25 times the total length of the backbone, or $0.25 * L$, using the terminology in the appealed claims. Because $0.25 * L$ falls within the ranges recited in claims 1, 13, and 14, we agree with the Examiner that the spacing of Wittwer’s attachment points meet the attachment point spacing limitations in those claims.

Moreover, because the distance between the two attachment points 31 and 32 is $\frac{1}{4}$, or 0.25, of the total length of the flexible backing strip, and because that ratio falls within the range of 0.1 and 0.35 recited in claim 2, we also agree with the Examiner that the spacing of Wittwer's attachment points meet the attachment point spacing limitation in claim 2.

Appellant reiterates the limitations in claims 1, 2, 13, and 14, and argues that Wittwer fails to meet all of the limitations of those claims (App. Br. 24-26).

We are not persuaded by these arguments. For the reasons discussed above, Wittwer's wiper meets the limitations in claims 1, 2, 13, and 14 of an elongate curved backbone made of a single, unitary, resiliently flexible beam, and also meets those claims' limitations regarding the distance between the connectors.

With respect to claim 14's requirement that the force applying member be connected to the backbone by a pin that is received in a longitudinal slot in the backbone so as to permit relative longitudinal and pivotal movement between the pin and the backbone, the Examiner responds that "the claws of Wittwer are U-shaped and have inwardly protruding pin-like structures to clip around the backbone which is received within longitudinal grooves to secure the claws to the backbone" (Ans. 10). Appellant does not dispute the Examiner's analysis that Wittwer's claws and grooves correspond to the claimed pin and longitudinal slot.

Thus, because Appellant has not shown that the Examiner erred in finding that Wittwer anticipates claims 1, 2, 13, and 14, and because we detect no deficiency in the Examiner's analysis, we affirm the Examiner's anticipation rejection of claims 1, 2, 13, and 14 over Witter as evidenced by

Thompson. Because they were not argued separately, claims 2-5 and 7-10 fall with claims 1, 2, 13, and 14. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OBVIOUSNESS

ISSUE

Claim 6 stands stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Wittwer and Appel (Ans. 5-6).

Conceding that Wittwer “fails to teach that the curved backing strip or beam has a varying width and thickness,” the Examiner nonetheless contends that one of ordinary skill would have considered it obvious “to modify the invention of Wittwer to have a backing strip or beam that varies in width and thickness as taught by Appel to provide substantially uniform pressure along the length of contact between the flexible rubber wiping blade and the windshield” (Ans. 5). Additionally, the Examiner reasons, such a configuration “would accommodate a correspondingly smaller radius of curvature while retaining appropriate width for resisting lateral drag loads without undue distortion” (*id.* at 5-6, (citing Appel, col. 1, ll. 34-48).

Appellant contends that “the combination of Wittwer et al. and Appel is improper because the windshield wiper assemblies disclosed in both of these patents is structurally dissimilar and because there is no motivation to combine the teachings of these references” (App. Br. 26).

The issue with respect to this rejection, therefore, is whether Appellant has shown that the Examiner erred in concluding that one of ordinary skill in the art would have considered claim 6 obvious in view of Wittwer and Appel.

FINDINGS OF FACT

18. Claim 6 recites “[t]he beam blade windscreen wiper as claimed in Claim 1, in which the curved backbone has a varying width and thickness, along its length.”

19. Appel discloses a windshield wiper blade assembly having a “single spring element . . . as a backbone to which is mounted a conventional flexible rubber wiping blade which together operate to distribute a centrally applied actuating arm pressure load relatively uniformly along the length of the blade throughout variations in windshield contour traversed by the wiper” (Appel, col. 1, ll. 23-28).

20. Appel discloses that its wiper blade spring element has “a varying width and/or thickness . . . from a maximum near the central arm attachment point to a minimum at the ends,” with the width, thickness and curvature “being proportioned with the modulus of elasticity, total pressure load and length of blade to provide substantially uniform pressure along the length of contact between the flexible rubber wiping blade and the windshield” (Appel, col. 1, ll. 34-41).

21. To meet extreme variation in windshield curvature, Appel discloses that “it may be desirable in some instances to taper the ends of the spring backbone element in thickness as well as in width in order to accommodate a correspondingly smaller radius of curvature while retaining appropriate width for resisting lateral drag loads without undue distortion” (Appel, col. 1, ll. 43-48).

PRINCIPLES OF LAW

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. “[The Examiner]

can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.”

In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (citations omitted, bracketed material in original). Thus, as the Supreme Court recently pointed out, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

While holding that some rationale must be supplied for a conclusion of obviousness, the Court nonetheless rejected a “rigid approach” to the obviousness question, and instead emphasized that “[t]hroughout this Court’s engagement with the question of obviousness, our cases have set forth an expansive and flexible approach” *Id.* at 1739. The Court also rejected the use of “rigid and mandatory formulas” as being “incompatible with our precedents.” *Id.* at 1741; *see also* 1742-43 (“Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.”).

The Court thus reaffirmed “the conclusion that when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at 1740 (quoting *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)). The Court explained that a “patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.”

Id. at 1739 (quoting *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950)).

The Court reasoned that the analysis under 35 U.S.C. § 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* The Court further advised that “[a] person of ordinary skill is . . . a person of ordinary creativity, not an automaton.” *Id.* at 1742.

Regarding hindsight reasoning, the Court stated that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.” *Id.* at 1742-43 (citations omitted).

ANALYSIS

Appellant’s arguments do not persuade us that the Examiner erred in concluding that claim 6 would have been obvious to one of ordinary skill in the art (*see* Ans. 5-6)

Appellant argues that because Wittwer discloses a tournament style wiper blade, whereas Appel discloses a beam blade assembly, “both the Wittwer et al. and the Appel patent would each have to be substantially reconstructed in order to begin to approach the device disclosed in independent claim 1, as it is further modified by dependent claim 6,” thus violating the “fundamental axiom in patent law that if a reference must be reconstructed or rearranged to change its operation to meet the applicant’s

claim, that modification of the reference is inappropriate and cannot stand” (App. Br. 28).

We are not persuaded by this argument. One of ordinary skill viewing Wittwer and Appel would have recognized that both references are directed to wiper blade assemblies that have a single curved flexible backing member to which force is applied (*see* FF 13, 14, 19, 20). Moreover, a person of ordinary skill would have recognized from Wittwer that it was desirable to distribute pressure to all portions of the wiper blade as uniformly as possible (*see* FF 15).

One of ordinary skill would have been further advised by Appel that varying the width and thickness of a unitary wiper blade backing member allowed uniform distribution of pressure to the blade as well as compensating for varying curvature of the windshield (FF 20, 21). Thus, we agree with the Examiner that one of ordinary skill, being a person of ordinary creativity and common sense, *see KSR* 127, S. Ct. a 1742-43, would have been prompted to vary the width and thickness of Wittwer’s blade backing member so as to ensure uniform pressure distribution as well as optimal application of the blade to a curved windshield.

Because this modification only requires changing the width of Wittwer’s blade to achieve Appel’s varying width/thickness configuration, we do not agree with Appellant that the asserted combination of references requires substantial reconstruction of the prior art structures. Moreover, because the suggestion for combining the references’ features would have come from the references themselves, we do not agree that the asserted combination of references would only have been made through hindsight.

We therefore affirm the Examiner’s obviousness rejection of claim 6.

SUMMARY

We reverse the Examiner's rejection of claims 1-10, 13, and 14 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

We affirm the Examiner's rejection of claims 1-5, 7-10, 13, and 14 under 35 U.S.C. § 102(b) as anticipated by Wittwer as evidenced by Thompson.

We affirm the Examiner's rejection of claim 6 under 35 U.S.C. § 103(a) as being obvious in view of Wittwer and Appel.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED

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